

Serial No. 10/672,089
Docket No. ADO 0102 PA

-7-

REMARKS

In the latest Office Action, claims 1-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbard et al., U.S. Patent No. 5,234,987, in view of Weih et al., U.S. Patent No. 6,268,422. The Examiner continues to take the position that it would have been obvious to combine the teachings of the references, reasoning that motivation for the combination exists in view of the EPA regulation of VOC emissions "which have led the solvent based coating industry to form aqueous coatings in many instances." Applicants strongly disagree. There is no specific teaching or suggestion in Weih which would motivate one skilled in the art to modify Hubbard's compositions to form low VOC aqueous dispersions. And, the Examiner's generalized speculation about what would be desirable with respect to the "solvent based coating industry" is insufficient as an evidentiary matter to carry the Examiner's burden of establishing a case of prima facie obviousness.

As previously pointed out, Weih et al. teach the use of a "stabilizing solvent" which is used in an emulsion polymerization reaction. Hubbard et al. do not teach such an emulsion polymerization reaction and thus have no need for a "stabilizing solvent." Weih's teachings are specific to the particular latex formulation described therein.

Further, while the Examiner refers to col. 5, lines 7-15, of Weih as encompassing the claimed ratio of solvent/water, applicant wishes to point out that the emulsification mixture of Weih is an intermediate composition; i.e., the final composition contains no solvent. As taught in Example 1 of Weih, after adding polyvinyl alcohol, methanol, $\text{Na}_2\text{S}_2\text{O}_5$, and 856 g. of water, the mixture is heated, and two monomers are then dissolved separately in an amount of water and added to the solvent mixture prior to vacuum stripping to remove the methanol. It is not clear from Weih's disclosure how much of the intermediate mixture comprises water and how much comprises VOC. Accordingly, one skilled in the art would not look to Weih, which teaches a solvent/water mixture only at an intermediate step, to modify Hubbard et al. to arrive at the claimed ratio of water to VOC compound in a final primer composition as recited in claims 13 and 26.

Serial No. 10/672,089
Docket No. ADO 0102 PA

-8-

Further, Weih teaches VOCs comprising low molecular weight alcohols (e.g., methanol) and ethers that can be vacuum stripped from the final product, i.e., the VOCs have high vapor pressures. The preferred VOCs used in the present invention are hydrocarbons, ketones and esters (see claims 6 and 18). Weih does not teach or suggest the use of such VOCs. And, as pointed out above, Weih does not desire any VOCs in his final product, i.e., he vacuum strips out the VOCs "so as to avoid the presence of any volatile material in the final latex." (See col. 4, lines 11-16). This teaching clearly differs from Hubbard et al., who require VOCs in order to be able to apply their product. See Hubbard et al. Examples 1 and 2.

Accordingly, there is no motivation for one skilled in the art to combine the teachings of Weih and Hubbard et al. because 1) Weih's solvents are used for a different purpose, i.e., emulsion polymerization; 2) Weih's final product contains no VOCs, whereas Hubbard's final product requires VOCs; and 3) Weih's VOCs are different than those claimed. Thus, even if the teachings of the references were combined, claims 6 and 18 would not be met. Nor would claims 12-21 be met as neither of the references teaches or suggests the specific amounts of components recited in those claims.

Applicant further wishes to reiterate that a generalized desire to meet unspecified EPA regulations is insufficient to provide the specific motivation to combine the reference teachings. Weih relates to a different composition that contains no VOCs. The Examiner has failed to provide evidence or reasoning as to how to combine the references to produce the claimed primer composition.

With regard to claims 2, 3, 14, 15, and 27, which recite the inclusion of a plasticizer, the Examiner has taken the position that the stabilizing solvent of Weih functions as a plasticizer as it "lowers the Tg of the polymer, i.e., softens it." However, there is no teaching or suggestion in Weih et al. that their stabilizing solvent functions as a plasticizer. In fact, Weih teaches the optional inclusion of a plasticizer at col. 9, line 60. However, Weih does not teach or suggest the use of the specific claimed plasticizers, nor is there any teaching of the claimed amounts of plasticizers.

Serial No. 10/672,089
Docket No. ADO 0102 PA

-9-

For all of the above reasons, applicants submit that claims 1-27 are clearly patentable over the cited references. Early notification of allowable subject matter is respectfully requested.

Respectfully submitted,
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